

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed August 11, 2009. At the time of the Office Action, Claims 1-33 were pending in this Application. Claims 1-33 were rejected. Claims 1, 16, 17, and 19 are herein amended. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 1-5, 7-23 and 25-33 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2002/0133405 filed by Scott G. Newnam (“*Newnam*”) in view of U.S. Patent 7,161,934 issued to Luiz Buchsbaum et al. (“*Buchsbaum*”) and further in view of U.S. Patent 7,380,260 issued to James A. Billmaier et al. (“*Billmaier*”).

Claims 6 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Newnam* in view of *Buchsbaum* and further in view of *Billmaier*.

Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, do not render the claimed embodiment of the invention obvious.

In order to establish a prima facie case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on ex post reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination

was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Applicants submit that none of the cited references teaches the central feature of Applicants' invention -- namely, ***an interactive information exchange between satellite-based communications and non- satellite-based communications***. For example, Claim 1 recites "communicating user feedback regarding one or more of the functions furnished by the information transmission received via the satellite connection from the remote data processing equipment to the production studio via the non-satellite connection." (Independent Claims 16, 17, and 19 recite similar limitations.)

The Examiner alleges that the proposed *Newnam-Buchsbaum-Billmaier* combination teaches this limitation, but then points only to *Newnam*, paragraphs 0029-0036 as teaching this limitation. However, even the Examiner acknowledges that *Newnam* does not teach a satellite connection between the production studio and remote client. (Office Action, page 3). Thus, it is unclear where the Examiner believes the references teach the recites *interactive information exchange between satellite-based communications and non- satellite-based communications*.

Applicants can only assume that the Examiner believes some combination of *Newnam* and *Buchsbaum* can arrive at this feature. However, *Newnam* teaches a ***fully non-satellite-based interactive information exchange*** between technical director 300 and client device 50. To somehow modify *Newnam*'s system to include *satellite-based* communication of video and digital information from technical director 300 and client device 50, while retaining *non-satellite-based* feedback communications from client device 50 to technical director 300, would clearly change the principle of operation of Newnam. M.P.E.P. 2143.01(VI) instructs "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." (citations omitted).

Moreover, *Newnam* explicitly teaches away from such a modification. *Newnam* teaches:

[0038] In FIG. 3, and embodiment of the present invention is compared to a prior art system. In a prior art system, a head-end facility 400 sends an on-air broadcast signal with embedded ATVEF triggers 430 to the set-top client 110. The ATVEF trigger specifies a URL. The set-top client 110 sends a URL request 440 to the web Server 420. The web server 420 serves up a web page 450 to the set-top client 110.

[0039] **The system of the present invention decouples the distribution and production of on-line enhanced TV programming from the production and distribution of the on-air broadcast.** The server system 200 provides the mechanism of synched on-line program 210 over IP without embedding ATVEF triggers in the on-air broadcast signal. The on-air broadcast signal 410 is delivered by the head-end facility 400 to the set-top client 110. In the system of the present invention the ATVEF triggers do not have to be embedded in the on-air broadcast 410. This ability to avoid embedded triggers allows producers other than the on-air broadcast producers to create on-line programming. Furthermore, the system of the present invention can prevent MSOs (the operators of the head-end facility 400) from restricting the availability of interactive programming by removing ATVEF triggers from the signal 430 provided to the set-top client 110.

Thus, *Newnam* teaches decoupling the digital data for an interactive information exchange with the client from the on-air video broadcast, and sending the interactive information exchange data *on-line* rather than *on-air*. Thus, *Newnam* explicitly teaches away from the claimed feature of *satellite-based broadcast* of the information used for the interactive information exchange with a client.

For at least these reasons, Applicants submit that none of the cited references teaches the key feature of *an interactive information exchange between satellite-based communications and non- satellite-based communications*, and in fact teach away from this feature. Accordingly, Applicants respectfully request reconsideration of independent Claims 1, 16, 17, and 19, as well as all claims that depend therefrom.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of all pending Claims.

Applicants believe there are no other fees due at this time. However, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

Respectfully submitted,
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